



MAIL

Paper No. 10

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Shigeki Ohbayashi)
Application No. 09/196,136)
Filed: November 20, 1998) **DECISION ON PETITION UNDER 37**
For: SEMICONDUCTOR INTEGRATED) **C.F.R. § 1.181 TO WITHDRAW**
CIRCUIT HAVING BONDING) **HOLDING OF ABANDONMENT**
OPTIONAL FUNCTION)

This is a decision on the Request for Reconsideration filed September 9, 2002 in response to the decision (Paper No. 8, mailed May 9, 2002) Dismissing Applicant's petition under 37 C.F.R. § 1.181 requesting the Withdrawal of the Holding of Abandonment. (See MPEP § 711.03(c)).

The petition is **DENIED**.

This application was held abandoned for failure to timely file a proper reply to the Office Action of mail date August 16, 2001. A Notice of Abandonment was mailed on April 18, 2002.

In the absence of any apparent irregularity associated with the mailing of an Office communication, the Office may presume that the communication was properly mailed to the address of record. This presumption may be overcome by showing that the Office communication was not received.

RECENT CASE HISTORY

January 19, 2001	-	Office Action (Paper No. 2) mailed setting a shortened statutory period of response to expire three months from the mailing date of the action.
July 25, 2001	-	Applicant filed a Correspondence Address Change (Paper No. 3)
August 16, 2001	-	Office Action of January 19, 2001 remailed (Paper No. 4) resetting the period of reply to expire three months from the mailing date of the remailed action.
April 18, 2002	-	Notice of Abandonment (Paper No. 6) was mailed.
May 6, 2002	-	Applicant filed Petition to Withdraw the Holding of Abandonment.

- May 9, 2002 - Petition is dismissed. The petition explains that the August 16, 2001 remailing was unauthorized and the abandonment is actually caused by failure to respond the Office action of January 19, 2001. The original petition was dismissed because Applicant's submission did not provide evidence of non-receipt with respect to the address of record. The address of record at the time the January 19th Office Action was mailed was Applicant's address at Canal Center Plaza, in Alexandria, VA.
- September 9, 2002 - Applicant filed Request for Reconsideration of Petition decision.

BASIS OF OPINION

The relevant portions of the Statutes and Rules which were not part of the original decision are reproduced below. Emphasis is added to draw attention to the critical phrases.

M.P.E.P. §601.03 Change of Correspondence Address

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application pro se) changes his or her correspondence address, *he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address* (including ZIP Code). The notification should also include his or her telephone number.

Unless the correspondence address is designated as the address associated with a Customer Number, a separate notification must be filed in each application for which a person is intended to receive communications from the Office. See **MPEP § 403 for Customer Number Practice**. In those instances where a change in the correspondence address of a registered attorney or agent is necessary in a plurality of applications, the notification filed in each application may be a reproduction of a properly executed, original notification. The original notice may either be sent to the Office of Enrollment and Discipline as notification to the Attorney's Roster of the change of address, or may be retained by applicant. See MPEP § 502.02.

M.P.E.P. §403 Correspondence —With Whom Held

The Office will also *accept requests submitted electronically via a computer-readable diskette to:*

- (A) change the correspondence address of a list of applications or patents or the fee address for a list of patents to the address associated with a Customer Number; and
- (B) submit a power of attorney in a list of applications or patents to the registered practitioners associated with the Customer Number.

Such electronic requests *must be submitted in the manner set forth* in the Notice entitled "Extension of the Payor Number Practice (through "Customer Numbers") to Matters Involving Pending Patent Applications," published in the Federal Register at 61 FR 54622, 54623-24 (October 21, 1996), and in the Official Gazette at 1191 O. G.187, 188-89 (October 29, 1996).

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...

The PTO will also accept requests submitted electronically *via a computer-readable diskette* to:
(1) change the correspondence address of a list of applications or patents or the fee address for a list of patents to the address associated with a Customer Number;

...

Persons electronically submitting such a request must submit an IBM-compatible diskette containing a Microsoft Excel spreadsheet, or a comma separated text file which can be imported into Microsoft Excel spreadsheet, ...

The diskette contained on the spreadsheet into PTO records for the listed applications or patents. In addition, for any application or patent listed on such spreadsheet, the cover letter must be signed by the applicant or patentee, assignee in compliance with 37 CFR 3.73(b), or registered practitioner of record in the patent or application. *The PTO will issue a written confirmation* of the list of applications or patents indicating the change(s) entered into PTO records.

OPINION

The previous decision dismissed applicant's petition stating:

Applicant's submission provides evidence that the Office Action was not received at the firm's Washington DC address. To overcome the presumption of proper mailing, a showing must be made with respect to the address of record. The address of record at the time the January 19th Office Action was mailed was Applicant's address at Canal Center Plaza, in Alexandria, VA. Since the showing was made with respect to the Washington DC address and not Applicant's address in Alexandria, VA, the showing is insufficient. *Furthermore, the showing of nonreceipt must be made for the January 19th Office Action, not the August 16th remailing.*

In the request for reconsideration, Petitioner attempts to establish that the Office action of January 19, 2001, was mailed to an incorrect address. Petitioner states that an electronic Change of Address for Customer No. 020277 was filed **by e-mail** on August 29, 2000. (Emphasis added).

Applicant bears the responsibility for informing the Office of a change in correspondence address. The Office has established procedures for electronic submission of change of address requests. Applicant has not employed that procedure.

There is no provision for filing requests for change of correspondence address by e-mail. As per the guidelines published in the Notice entitled "Extension of the Payor Number Practice (through "Customer Numbers") to Matters Involving Pending Patent Applications," electronic submissions must (1) be on IBM-compatible diskette; (2) be accompanied by (i) a paper copy of the spreadsheet and (ii) a cover letter requesting entry of the changes.

Applicant's submission did not comply with these requirements. Accordingly, the retention of the original address in the application is in conformance with Office practice.

CONCLUSION

Applicant failed to provide a proper request for change of correspondence address. Therefore, the address of record at the time the January 19th Office Action was mailed was Applicant's address at Canal Center Plaza, in Alexandria, VA. The Office action was properly mailed to that address.

Because Applicant failed to provide a timely reply to the Office Action of mail date January 19, 2001, within the 3 month shortened statutory period or the maximum 6 month statutory period, the application was correctly abandoned.

Accordingly, the petition for Withdrawal of Holding of Abandonment is **DENIED**.

If the petitioner desires further review of the Director's decision, applicant should consider filing a Petition for Review of the Director's Decision under 37 C.F.R. § 1.181(a)(3).

Inquiries with respect to this decision may be directed to Special Programs Examiner Pinchus M. Laufer at (703) 306-4160.



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